

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Robert E. Haines et al.

Confirmation No.: 1659

Application No.: 09/976,625

Examiner: Thomas J. Lett

Filing Date: 10/11/2001

Group Art Unit: 2625

Title: — Unique Identifier for Customer Account and Method

Mail Stop Appeal Brief-Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF

Sir:

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on June 23, 2006.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) \$500.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

() (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d) for the total number of months checked below:

() one month	\$120.00
() two months	\$450.00
() three months	\$1020.00
() four months	\$1590.00

() The extension fee has already been filled in this application.

() (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account **08-2025** the sum of \$500.00. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

N I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, Alexandria, VA 22313-1450. Date of Deposit: 9/25/2006

OR

() I hereby certify that this paper is being transmitted to the Patent and Trademark Office facsimile number _____ on _____

Number of pages: 33

Typed Name: Natalie King

Signature: 

Respectfully submitted,

Robert E. Haines et al.

By 

James D. Shaurette

Attorney/Agent for Applicant(s)

Reg. No. **39,833**

Date: 9/25/06

Telephone No.: (509) 624-4276



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Serial No.09/976,625
Filing Date..... October 11, 2001
InventorRobert E. Haines et al.
Assignee..... Hewlett-Packard Development Company, L.P.
Group Art Unit 2625
Examiner.....Thomas J. Lett
Attorney's Docket No. PDNO. 10007584-1
Confirmation No..... 1659
Title: Unique Identifier for Customer Account and Method

BRIEF OF APPELLANT

To: Mail Stop Appeal Brief-Patents
 Commissioner of Patents
 P.O. Box 1450
 Alexandria VA 22313-1450

From: James D. Shaurette (Tel. 509-624-4276; Fax 509-838-3424)
 Wells, St. John, P.S.
 601 W. First Avenue, Suite 1300
 Spokane, WA 99201-3817

Appellant appeals from the Office Action mailed March 23, 2006 (hereinafter "Office Action" or "Action"). The Commissioner is authorized to charge the fee required under 37 C.F.R. § 41.20(b)(2) to Deposit Account No. 08-2025.

09/28/2006 BABRAHA1 00000071 082025 09976625

01 FC:1402 500.00 DA

PDNO. 10007584-1
Serial No. : 09/976,625
Brief of Appellant



TABLE OF CONTENTS

I.	REAL PROPERTY IN INTEREST	1
II.	RELATED APPEALS AND REFERENCES	1
III.	STATUS OF CLAIMS.....	1
IV.	STATUS OF AMENDMENTS.....	1
V.	SUMMARY OF CLAIMED SUBJECT MATTER	1
VI.	GROUND OF REJECTION TO BE REVIEWED ON APPEAL	4
VII.	ARGUMENT.....	5

A. Positively-recited limitations of claims 1-42 are not disclosed nor suggested by the teachings of Sampath and the 102 rejection is improper for at least this reason.....5

B. Positively-recited limitations of claims 28 and 32 are not disclosed nor suggested by the teachings of Sampath and the 102 rejection is improper for at least this reason.....7

C. Positively-recited limitations of claims 29-32 and 34 are not disclosed nor suggested by the teachings of Sampath and the 102 rejection is improper for at least this reason.....9

D. Positively-recited limitations of claims 30 and 31 are not disclosed nor suggested by the teachings of Sampath and the 102 rejection is improper for at least this reason.....10

E. Positively-recited limitations of claim 33 are not disclosed nor suggested by the teachings of Sampath and the 102 rejection is improper for at least this reason.....11

F. Positively-recited limitations of claim 35 are not disclosed nor suggested by the teachings of Sampath and the 102 rejection is improper for at least this reason.....11

G.	Positively-recited limitations of claims 36 and 37 are not disclosed nor suggested by the teachings of Sampath and the 102 rejection is improper for at least this reason.....	12
H.	Positively-recited limitations of claim 38 are not disclosed nor suggested by the teachings of Sampath and the 102 rejection is improper for at least this reason.....	13
I.	Conclusion.....	13
VIII.	APPENDIX A – THE CLAIMS INVOLVED IN THIS APPEAL.....	A-1
IX.	APPENDIX B – EVIDENCE APPENDIX	B-1
X.	APPENDIX C – RELATED PROCEEDINGS.....	C-1



REAL PARTY IN INTEREST

The real party in interest of this application is Hewlett-Packard Development Company, L.P. as evidenced by the full assignment of the pending application to Hewlett-Packard Company recorded starting at Reel 012594, Frame 0589, and the full assignment to Hewlett-Packard Development Company, L.P. recorded starting at Reel 014061, Frame 0492, in the Assignment Branch of the Patent and Trademark Office. The Hewlett-Packard Development Company, L.P., is a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holdings, LLC.

II. RELATED APPEALS AND INTERFERENCES

Appellant, Appellant's undersigned legal representative, and the assignee of the pending application are aware of no appeals or interferences which will directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF THE CLAIMS

Claims 1-42 pending and stand rejected. Appellant appeals the rejection of claims 1-42

IV. STATUS OF AMENDMENTS

No amendments have been filed after the Office Action mailed March 23, 2006.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Concise explanations of the subject matter defined in each of the independent claims and argued dependent claims involved in the appeal follow with respect to exemplary illustrative embodiments of the specification and figures.

Referring to independent claim 1, determining that a status change has occurred is illustrated in Fig. 7 at step S61 and described at page 14, lines 4+ in

*PDNO. 10007584-1
Serial No. : 09/976,625
Brief of Appellant*

one embodiment. As set forth at page 14, lines 4+ of the specification, sensors 22 may detect a quantity of a consumable has decreased below a level set or predetermined level, or detect that a maintenance notification threshold has been exceeded. As set forth at page 14, lines 8+, a device identifier may be combined with a detected consumable or maintenance threshold with respect to a step S62 of Fig. 7. The electronic message may be transmitted as described at step S63 of Fig. 7 and page 14, lines 22+ of the specification.

Referring to independent claim 8, a controller 20 in the form of a processor and memory 24 of a hard copy output engine 14 are shown in Fig. 1 and described at page 4, lines 2+. At page 6, lines 19+, additional details regarding a processor and memory are described according to the exemplary embodiment of Fig. 1. Determination that a status change has occurred is illustrated in Fig. 7 at step S61 in one embodiment. As set forth at page 14, lines 4+ of the specification, sensors 22 may detect a quantity of a consumable has decreased below a level set or predetermined level, or detect that a maintenance notification threshold has been exceeded. As set forth at page 14, lines 8, a device identifier may be combined with a detected consumable or maintenance threshold with respect to a step S62 of Fig. 7. The electronic message may be transmitted as described at step S63 of Fig. 7 and page 14, lines 22+ of the specification.

Referring to independent claim 15, an exemplary control system for a hard copy output engine 14 may be implemented using the controller described at page 6, lines 19+ of the specification. Processor 20 and memory 24 of a hard copy output engine 14 are shown in Fig. 1 and described at page 4, lines 2+. At page 6, lines 19+, additional details regarding a processor and memory are described according to the exemplary embodiment of Fig. 1. Determination that a status change has occurred is illustrated in Fig. 7 at step S61 in one embodiment. As set forth at page 14, lines 4+ of the specification, sensors 22 may detect a quantity of a consumable has decreased below a level set or predetermined level, or detect that a maintenance notification threshold has been exceeded. As set forth at page 14, lines 8, a device identifier may be combined with a detected consumable or maintenance threshold with respect to a step S62 of Fig. 7. The electronic message may be transmitted as described at step S63 of Fig. 7 and page 14, lines 22+ of the specification.

Referring to independent claim 21, it is stated at page 6, lines 26+ of the specification that hard copy output engine 14 accepts instructions as a computer instruction signal embodied in a carrier wave carrying instructions by a controller 20 which may be a processor. Determination that a status change has occurred is illustrated in Fig. 7 at step S61 in one embodiment. As set forth at page 14, lines 4+ of the specification, sensors 22 may detect a quantity of a consumable has decreased below a level set or predetermined level, or detect that a maintenance notification threshold has been exceeded. As set forth at page 14, lines 8, a device identifier may be combined with a detected consumable or maintenance threshold with respect to a step S62 of Fig. 7. The electronic message may be transmitted as described at step S63 of Fig. 7 and page 14, lines 22+ of the specification.

Referring to dependent claim 28, as set forth at page 14, lines 8+, server 26 of device 14 may combine a device identifier with a detected consumable or maintenance threshold with respect to a step S62 of Fig. 7.

Referring to dependent claim 29, as set forth at page 14, lines 22+, server 26 of device 14 may transmit an electronic message.

Referring to dependent claim 30, orders relating to hard copy output devices are described in one embodiment at page 14, lines 30+ of the specification.

Referring to dependent claim 31, orders relating to hard copy output devices are described in one embodiment at page 14, lines 30+ of the specification.

Referring to dependent claim 32, as set forth at page 14, lines 8+, server 26 of device 14 may combine a device identifier with a detected consumable or maintenance threshold with respect to a step S62 of Fig. 7. As set forth at page 14, lines 22+, server 26 of device 14 may transmit an electronic message.

Referring to dependent claim 33, an electronic message may be sent as described at step S63 of Fig. 7 and page 14, lines 22+ of the specification following detection of status.

Referring to dependent claim 34, an electronic message may be sent as described at step S63 of Fig. 7 and page 14, lines 22+ of the specification following detection of status.

Referring to dependent claim 35, a processor in communication with a computer usable medium such as memory 24 of a peripheral device such as a hard

copy output engine 14 are shown in Fig. 1 and described at page 4, lines 2+ of the specification.

Referring to dependent claim 36, a controller 20 which may be in the form of a processor of hard copy output engine 14 is shown in Fig. 1 and described at page 4, lines 2+ of the specification.

Referring to dependent claim 37, a controller 20 which may be in the form of a processor of a hard copy output engine 14 and memory 24 are shown in Fig. 1 and described at page 4, lines 2+ of the specification.

Referring to dependent claim 38, a processor of a peripheral device such as a hard copy output engine 14 is shown in Fig. 1 and described at page 4, lines 2+ of the specification.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

- A. The 102 rejection of claims 1-42 over Sampath.
- B. The 102 rejection of claims 28 and 32 over Sampath.
- C. The 102 rejection of claims 29-32 and 34 over Sampath.
- D. The 102 rejection of claims 30 and 31 over Sampath.
- E. The 102 rejection of claim 33 over Sampath.
- F. The 102 rejection of claim 35 over Sampath.
- G. The 102 rejection of claims 36 and 37 over Sampath.
- H. The 102 rejection of claim 38 over Sampath.

VII. ARGUMENT

A. Positively-recited limitations of claims 1-42 are not disclosed nor suggested by the teachings of Sampath and the 102 rejection is improper for at least this reason.

Referring to the anticipation rejections, Applicant notes the requirements of MPEP §2131 (8th ed., rev. 3), which states that TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM. The **identical invention** must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Referring to independent claim 1, the method recites *determining that a status change has occurred in a peripheral device*. The Office at page 3 of the Action relies upon col. 5, lines 61-64 of Sampath as allegedly teaching the claimed determining. However, the teachings in col. 5 merely refer to receiving *status information* from a monitored electronic system. There is no evidence of record that the mere receiving of *status information* teaches *determining that a status change has occurred in the peripheral device* as explicitly claimed. The claimed determining is not disclosed nor suggested by the prior art and claim 1 is allowable for at least this reason.

Claim 1 additionally positively claims *combining a unique device identifier* relevant to the peripheral device with the status change to form an electronic message. At page 4 of the Action, the Office relies upon col. 10, lines 28-30 of Sampath as allegedly disclosing the claimed combining. However, the teachings in col. 10 refer to acquiring a *job identifier* which is issued *after a job is completed responsive to a job request*. The job identifier of Sampath fails to disclose or suggest a *unique device identifier* as positively recited in claim 1. Appellants respectfully submit claim 1 is allowable for this additional reason.

In addition, the teachings of col. 10, lines 28-30 of Sampath and relied upon by the Office teach a determined diagnosis event and job identifier *are acquired for repair planning*. Appellants respectfully submit that the mere *acquisition* of the determined diagnosis event and job identifier fail to disclose or suggest any

combining, let alone the combining to form an electronic message as explicitly claimed. In addition, Sampath fails to teach any *combining of a status change* with a unique device identifier as specifically claimed. Appellants respectfully submit claim 1 is allowable for this additional reason.

The Office additionally recites step 48 and col. 10, lines 47-52 of Sampath as allegedly disclosing the claimed combining. Step 48 and the respective teachings of col. 10 of Sampath relied upon by the Office teach that an identification or instructions for a customer repair, a machine identification and a repair identification are forwarded to a customer site. The mere forwarding fails to teach any combining inasmuch as the identification or instructions for a customer repair, the machine identification and the repair identification may be forwarded individually and there is no teaching of combining in conjunction with the forwarding. The combining recited in claim 1 is not disclosed nor suggested by Sampath and the rejection is improper for at least this reason.

In addition, the Office has identified the status information of col. 5 as allegedly disclosing the claimed status change. Appellants have failed to uncover any teachings in col. 10, lines 28-30 of Sampath (and relied upon by the Office as teaching the claimed combining) that *the status information of col. 5 identified as allegedly disclosing the status change is combined with anything let alone the specifically claimed combining of the status change with the unique device identifier*. Also, there is no evidence of record that the status information of col. 5 corresponds to the identification or instructions for a customer repair, a machine identification and a repair identification of col. 10, lines 47-52. The Office alleges on page 2 of the Office Action that the repair identification is analogous to a status change and recites teachings in col. 10, lines 1-46. However, col. 10, lines 1-46 fail to mention repair identification. Appellants respectfully submit there is no evidence of record that the repair identification of Sampath is analogous to a status change, and regardless, there is no evidence that the repair identification of Sampath is combined with a unique device identifier as claimed.

At page 2 of the Action, the Office baldly states that the status data of Table 1 of Sampath would inherently have combined a unique identifier and trouble request so that the destination would know which machine has a problem. It is further baldly alleged that Sampath would have to have unique identifiers in order

for user, system, supplier or technician to know to which machine to associate the repair or trouble. Appellants respectfully submit that the reliance upon inherency is misplaced. In particular, the Office must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied prior art. *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). MPEP 2112 IV (8th ed., rev. 3). Appellants respectfully submit other suitable alternatives apart from Appellants' specifically claimed embodiment of claim 1 exist and accordingly the reliance upon inherency in support of the 102 rejection is misplaced in view of the above-recited authority. In particular, an identifier of a machine may be communicated apart from a status change without the claimed combination in one possible suitable alternative arrangement. In another embodiment, dedicated communication lines for respective monitored systems 200 may be used without unique device identifiers. Accordingly, this existence of other suitable alternatives illustrates that the claimed combining of the unique device identifier with the status change does not necessarily flow from the teachings of Sampath and the reliance upon inherency is improper. Furthermore, there is no evidence in Table 1 of the claimed status change which is claimed.

Finally, the generic teachings of firewalls of col. 2 and Figs. 3A/3B relied upon by the Office at pages 4 and 2 of the Office Action, respectively, fail to disclose or suggest the limitations of transmitting the electronic message formed by combining the unique device identifier and the status change across the firewall as defined in claim 1.

Appellants respectfully submit that numerous positively-recited limitations of the claims are not taught by the prior art and the Office has failed to establish a proper 102 rejection for at least these reasons.

B. Positively-recited limitations of claims 28 and 32 are not disclosed nor suggested by the teachings of Sampath and the 102 rejection is improper for at least this reason.

The claims recite that the combining the unique device identifier with the status change comprises combining using the peripheral device. The Office on page 7 of the Action relies upon the teachings in col. 5, lines 61-62 and col. 6,

lines 10-13 of Sampath in support of the rejection. However, the teachings of col. 5 refer to *prediction/diagnostic circuit 150 which is a component of the diagnostic server 100 as shown in Fig. 1 as opposed to monitored systems 200 or any other structure which may be fairly considered to disclose or suggest a peripheral device.* The teachings of col. 5 of Sampath relied upon by the Office fail to disclose or suggest the claimed *combining of the unique device identifier with the status change using the peripheral device.* Furthermore, the teachings in col. 6 merely generically refer to status data that indicates one or more electronic systems have failed and any additional related device status information and fails to disclose the claimed combining recited in claim 28 using the peripheral device. Further, the teachings relied upon in col. 6 pertain to the repair planning circuit 165 which again is *a component of the diagnostic server 100* as shown in Fig. 1 and which may not be fairly interpreted to teach or suggest the claimed *combining using the peripheral device.* The combining using the peripheral device is not disclosed nor suggested by the prior art and claim 28 is allowable for at least this reason.

The Office appears to rely on "feedback diagnostic data" in support of the rejection as set forth on pages 2 and 7 of the Office Action. However, Applicants have failed to uncover any teachings of "feedback" in cols. 5 or 6. In addition, even if a monitored electronic system generates control data, event counts, fault counts, etc. as alleged on page 2 of the Action, such teachings fail to disclose or suggest the claimed *combining the unique device identifier with the status change using the peripheral device.*

The Office at page 7 of the Action relies upon teachings of col. 13, lines 28-33 of Sampath which discloses that the diagnosis and failure prediction system can be implemented by incorporating the system and method into software or hardware such as a workstation or dedicated system. However, there is absolutely no teaching of incorporating the diagnosis and failure prediction system into an electronic system 200 or other arrangement which may be fairly considered as a peripheral device. The Office has identified *no authority* in support of the bald allegation on page 7 of the Office Action that a workstation may be a printer, copier, mfp or other peripheral device as claimed. There is no teaching of reference 200 of Sampath or other arrangement which may be fairly considered as a

peripheral device performing *combining the unique device identifier with the status change*.

Appellants respectfully submit that numerous positively-recited limitations of the claims are not taught by the prior art and the Office has failed to establish a proper 102 rejection for at least these reasons.

C. Positively-recited limitations of claims 29-32 and 34 are not disclosed nor suggested by the teachings of Sampath and the 102 rejection is improper for at least this reason.

The claims recite the transmitting of claim 1 defining transmitting the electronic message across a firewall comprises *transmitting using the peripheral device*. The Office on page 7 of the Office Action relies upon the teachings of col. 5, lines 61-62 and col. 6, lines 10-13 of Sampath in support of the rejection of claim 29. However, the discussions of circuits 150 and 165 of cols. 5 and 6 refer to *circuits of the diagnostic server 100 as opposed to monitored systems 200* or any other structure which may be fairly considered to disclose or suggest a peripheral device. Appellants respectfully submit that the operations of the *diagnostic server 100* distinct of the printer monitored system 200 fail to disclose or suggest the claimed *transmitting using the peripheral device* and claim 29 is allowable.

Also with respect to the rejection of claim 29, Appellants have failed to uncover any teachings of "feedback diagnostic data" in the teachings of cols. 5 and 6. In addition, the Office fails to identify teachings or provide explanation as to how "feedback diagnostic data" is considered to disclose that the transmitting of the electronic message across the firewall comprises transmitting *using a peripheral device*.

Also, the Office at page 7 of the Action states that the diagnostic system and method may be incorporated into a software or hardware of a workstation with reference to col. 13, lines 28-33 of Sampath. The Office alleges without support that a workstation in the art may be a printer, copier, mfp, computer or similar remote device. Appellants respectfully submit the allegation is not supported by the prior art and the Office has failed to identify any teachings of the claimed *transmitting using a peripheral*. Appellants respectfully submit the teachings of the

Sampath reference teach a diagnostic server 100 which monitors the discrete monitored electronic system 200. Sampath discloses *two discrete devices or systems 100, 200* for the monitoring and the device being monitored (diagnostic server 100 performs the monitoring of a separate monitored system 200), and fails to teach or suggest the combination of the *claimed peripheral device which has a status change also transmits the claimed electronic message*.

Appellants respectfully submit that numerous positively-recited limitations of the claims are not taught by the prior art and the Office has failed to establish a proper 102 rejection for at least these reasons.

D. Positively-recited limitations of claims 30 and 31 are not disclosed nor suggested by the teachings of Sampath and the 102 rejection is improper for at least this reason.

Referring to dependent claims 30 and 31, the Office relies upon teachings of the *diagnostic server 100* routing an action request for service. However, the routing by the diagnostic server 100 fails to disclose or suggest *the transmission of the order using the peripheral device* as positively claimed in claim 30. At page 6 of the Action, the Office baldly alleges that the diagnostic system and method may be incorporated into a software or hardware of a workstation with reference to col. 13, lines 28-33 of Sampath. The Office alleges without supports that a workstation in the art may be a printer, copier, mfp, computer or similar remote device. Appellants respectfully submit the allegation is not supported by the prior art and the Office has failed to identify any teachings of the claimed transmitting of the order using a peripheral device. Appellants respectfully submit the teachings of the Sampath reference teach a diagnostic server 100 which monitors the discrete monitored electronic system 200, and fails to disclose transmission of the electronic message comprising an order using the monitored electronic system 200 or other arrangement which may be fairly considered as a peripheral device. Sampath discloses *two discrete devices or systems 100, 200* for the monitoring and the device being monitored (diagnostic server 100 performs the monitoring of a separate monitored system 200), and fails to teach or suggest the claimed peripheral device which has a status change also transmits the claimed order.

Referring to page 8 of the Action, the Office states that if the peripheral of Sampath needs a consumable or service, the diagnostic server 100 routes an action request. The teachings relied upon by the Office utilize two distinct systems or devices 100, 200 having the status (monitored device 100) and the separate system which routes the action request (server 200) as clearly distinguished from the claimed device having the status change and also transmitting the order.

Appellants respectfully submit that numerous positively-recited limitations of the claims are not taught by the prior art and the Office has failed to establish a proper 102 rejection for at least these reasons.

E. Positively-recited limitations of claim 33 are not disclosed nor suggested by the teachings of Sampath and the 102 rejection is improper for at least this reason.

Claim 33 positively claims that the *transmitting the electronic message across the firewall comprises transmitting responsive to the determining that a status change has occurred in the peripheral device*. The Examiner relies upon teachings of col. 5, lines 61-62 and col. 6, lines 10-13 of Sampath in support of the 102 rejection. The teachings in col. 5 disclose the circuit 150 receiving status and col. 6 teaches that the status data is any data that indicates one or more electronic systems have failed. The teachings relied upon by the Office are void of transmitting an electronic message across a firewall or the transmitting alone the claimed *transmitting of the electronic message responsive to the determining that a status change has occurred*.

Furthermore, the allegation that the diagnostic system and method may be incorporated into software or hardware of a workstation fails to teach or suggest the claimed transmitting an electronic message across a firewall or the transmitting responsive to the determining that a status change has occurred.

Appellants respectfully submit that numerous positively-recited limitations of the claims are not taught by the prior art and the Office has failed to establish a proper 102 rejection for at least these reasons.

F. Positively-recited limitations of claim 35 are not disclosed nor suggested by the teachings of Sampath and the 102 rejection is improper for at least this reason.

Claim 35 positively claims the processor comprising a processor of the peripheral device configured to determine that a status change has occurred in the peripheral device, combine a unique device identifier relevant to the peripheral device with the status change to form an electronic message, and transmit the electronic message across a firewall. The Examiner relies upon teachings of col. 9, lines 30-34 of Sampath in support of the rejection. However, the teachings relied upon by the Examiner refer to interrogation commands and control signals and fail to teach the claimed processor of the peripheral device configured to perform the claimed determining, combining and transmitting.

Appellants respectfully submit that numerous positively-recited limitations of the claims are not taught by the prior art and the Office has failed to establish a proper 102 rejection for at least these reasons.

G. Positively-recited limitations of claims 36 and 37 are not disclosed nor suggested by the teachings of Sampath and the 102 rejection is improper for at least this reason.

Claim 36 and 37 positively claim the processing circuitry comprising processing circuitry of the hard copy output engine configured to employ a software module to determine that a status change has occurred in the peripheral device, combine a unique device identifier relevant to the peripheral device with the status change to form an electronic message, and transmit the electronic message across a firewall. The Examiner relies upon teachings of col. 9, lines 30-34 of Sampath in support of the rejection. However, the teachings relied upon by the Examiner refer to interrogation commands and control signals and fail to teach the claimed processing circuitry of the hard copy output engine configured to perform the claimed determining, combining and transmitting.

At page 11 of the Action, the Office relies upon inherency to cure deficiencies of the teachings of the prior art with respect to claimed limitations. As mentioned above, the Office must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics

necessarily flow from the teachings of the applied prior art. Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). MPEP 2112 IV (8th ed., rev. 3). Appellants respectfully submit that the Office has failed to provide the requisite basis in fact and/or technical reasoning that the processing circuitry of the hard copy output engine performs the determining, combining and transmitting. Furthermore, alternatives exist, such as diagnostic server 100 performing one or all of the determining, combining and/or transmitting and the allegedly inherent limitations have not been demonstrated to necessarily flow from the teachings of the applied prior art. The reliance upon inherency is improper for at least these compelling reasons.

Appellants respectfully submit that numerous positively-recited limitations of the claims are not taught by the prior art and the Office has failed to establish a proper 102 rejection for at least these compelling reasons.

H. Positively-recited limitations of claim 38 are not disclosed nor suggested by the teachings of Sampath and the 102 rejection is improper for at least this reason.

Claim 38 recites the processor comprises a *processor of the peripheral device* in combination with the processor *determining that a status change has occurred in the peripheral device, combining a unique device identifier relevant to the peripheral device with the status change to form an electronic message, and transmitting the electronic message across a firewall*. The Examiner relies upon teachings of col. 9, lines 30-34 of Sampath in support of the rejection. However, the teachings relied upon by the Examiner refer to interrogation commands and control signals and fail to teach the claimed processor of the peripheral device performing the claimed determining, combining and transmitting.

Appellants respectfully submit that numerous positively-recited limitations of the claims are not taught by the prior art and the Office has failed to establish a proper 102 rejection for at least these reasons.

I. Conclusion

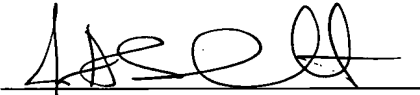
In view of the foregoing, reversal of the rejections of the claims is respectfully requested. For any one of the above-stated reasons, the rejections of

the respective claims should be reversed. In combination, the above-stated reasons overwhelmingly support such reversal. Accordingly, Appellants respectfully request that the Board reverse the rejections of the claims.

Respectfully submitted,

Date: 9/25/06

Attorney:


James D. Shaurette
Reg. No. 39,833



III. APPENDIX A – THE CLAIMS INVOLVED IN THIS APPEAL

1. [Original] A method of responding to a status change for a peripheral device comprising:

- determining that a status change has occurred in the peripheral device;
- combining a unique device identifier relevant to the peripheral device with the status change to form an electronic message; and
- transmitting the electronic message across a firewall.

2. [Original] The method of claim 1, wherein determining comprises determining that a quantity of a consumable has fallen below a predetermined threshold and wherein transmitting comprises transmitting the electronic message from an embedded web server contained in the peripheral device across a firewall.

3. [Original] The method of claim 1, wherein determining comprises determining that an order toner condition exists in a hard copy output engine.

4. [Original] The method of claim 1, wherein combining comprises combining the status change with a unique device identifier chosen from a group consisting of: a predetermined account number associated with the peripheral device, a serial number associated with the peripheral device, a vendor email address associated with the peripheral device or a universal resource locator for a web address for a vendor associated with the peripheral device.

5. [Original] The method of claim 1, wherein transmitting comprises transmitting an electronic message to a vendor of consumables and services relevant to the peripheral device.

6. [Original] The method of claim 1, wherein the peripheral device is chosen from a group consisting of: facsimile machines, photocopiers and printers.

1 7. [Original] The method of claim 1, wherein determining that a
2 status change has occurred comprises determining that a usage threshold
3 indicative of need for preventive maintenance has been met.

1 8. [Original] An article of manufacture comprising a computer usable
2 medium having computer readable code embodied therein that is configured to
3 cause a processor to:

4 determine that a status change has occurred in the peripheral device;
5 combine a unique device identifier relevant to the peripheral device with
6 the status change to form an electronic message; and
7 transmit the electronic message across a firewall.

1 9. [Original] The article of manufacture of claim 8, wherein the
2 computer readable code configured to cause a processor to determine comprises
3 computer readable code configured to cause the processor to determine that a
4 quantity of a consumable has fallen below a predetermined threshold and
5 wherein the computer readable code configured to cause a processor to transmit
6 comprises computer readable code configured to cause a process to transmit the
7 electronic message from an embedded web server contained in the peripheral
8 device across a firewall.

1 10. [Original] The article of manufacture of claim 8, wherein the
2 computer readable code configured to cause a processor to determine comprises
3 computer readable code configured to cause the processor to determine that an
4 order toner condition exists in a hard copy output engine.

1 11. [Original] The article of manufacture of claim 8, wherein the
2 computer readable code configured to cause a processor to combine comprises
3 computer readable code configured to cause the processor to combine the
4 status change with a unique device identifier chosen from a group consisting of:
5 a predetermined account number associated with the peripheral device, a serial
6 number associated with the peripheral device, a vendor email address associated

7 with the peripheral device or a universal resource locator for a web address for a
8 vendor associated with the peripheral device.

1 12. [Original] The article of manufacture of claim 8, wherein the
2 computer readable code configured to cause a processor to transmit comprises
3 computer readable code configured to cause the processor to transmit an
4 electronic message to a vendor of consumables and services relevant to the
5 peripheral device.

1 13. [Original] The article of manufacture of claim 8, wherein the
2 peripheral device is chosen from a group consisting of: facsimile machines,
3 photocopiers and printers.

1 14. [Original] The article of manufacture of claim 8, wherein the
2 computer readable code configured to cause a processor to determine comprises
3 computer readable code configured to cause the processor to determine that a
4 usage threshold indicative of need for preventive maintenance has been met.

1 15. [Previously Presented] A computer implemented control system for
2 a hard copy output engine, the system comprising:
3 memory configured to store a software module; and
4 processing circuitry configured to employ the software module to:
5 determine that a status change has occurred in the hard copy
6 output engine;
7 combine a unique device identifier relevant to the hard copy output
8 engine with the status change to form an electronic message; and
9 transmit the electronic message across a firewall.

1 16. [Previously Presented] The computer implemented control system
2 of claim 15, wherein the processor configured to employ the software module to
3 transmit comprises a processor configured to transmit an electronic message to
4 a vendor of consumables and services relevant to the hard copy output engine
5 and wherein the processor configured to employ the software module to

6 transmit comprises a processor configured to transmit the electronic message
7 from an embedded web server contained in the hard copy output engine across
8 a firewall.

1 17. [Original] The computer implemented control system of claim 15,
2 wherein the processor configured to employ the software module to determine
3 comprises a processor configured to employ the software module to determine
4 that a usage threshold indicative of need for preventive maintenance has been
5 met.

1 18. [Previously Presented] The computer implemented control system
2 of claim 15, wherein the processor configured to employ the software module to
3 combine comprises a processor configured to employ the software module to
4 combine the status change with a unique device identifier chosen from a group
5 consisting of: a predetermined account number associated with the hard copy
6 output engine, a serial number associated with the hard copy output engine, a
7 vendor email address associated with the hard copy output engine or a universal
8 resource locator for a web address for a vendor associated with the hard copy
9 output engine.

1 19. [Original] The computer implemented control system of claim 15,
2 wherein the hard copy output engine is chosen from a group consisting of:
3 facsimile machines, photocopiers and printers.

1 20. [Original] The computer implemented control system of claim 15,
2 wherein the processor configured to employ the software module to determine
3 comprises a processor configured to employ the software module to determine
4 that an order toner condition exists in a hard copy output engine.

1 21. [Original] A computer instruction signal embodied in a carrier wave
2 carrying instructions that when executed by a processor cause the processor to:
3 determine that a status change has occurred in the peripheral device;
4 combine a unique device identifier relevant to the peripheral device with
5 the status change to form an electronic message; and
6 transmit the electronic message across a firewall.

1 22. [Original] The computer instruction signal of claim 21, wherein the
2 computer instruction signal embodied in the carrier wave carrying instructions
3 that cause the processor to determine comprises a computer instruction signal
4 carrying instructions that when executed cause the processor to determine that
5 a quantity of a consumable has fallen below a predetermined threshold and
6 wherein the computer instruction signal configured to cause a processor to
7 transmit comprises a computer instruction signal carrying instructions that when
8 executed cause the processor to transmit the electronic message from an
9 embedded web server contained in the peripheral device across a firewall.

1 23. [Original] The computer instruction signal of claim 21, wherein the
2 computer instruction signal embodied in the carrier wave carrying instructions
3 that cause the processor to determine comprises a computer instruction signal
4 carrying instructions that when executed cause the processor to determine that
5 an order toner condition exists in a hard copy output engine.

1 24. [Original] The computer instruction signal of claim 21, wherein the
2 computer instruction signal embodied in the carrier wave carrying instructions
3 that cause the processor to combine comprises a computer instruction signal
4 carrying instructions that when executed cause the processor to combine the
5 status change with a unique device identifier chosen from a group consisting of:
6 a predetermined account number associated with the peripheral device, a serial
7 number associated with the peripheral device, a vendor email address associated
8 with the peripheral device or a universal resource locator for a web address for a
9 vendor associated with the peripheral device.

1 25. [Original] The computer instruction signal of claim 21, wherein the
2 computer instruction signal embodied in the carrier wave carrying instructions
3 that cause the processor to transmit comprises a computer instruction signal
4 carrying instructions that when executed cause the processor to transmit an
5 electronic message to a vendor of consumables and services relevant to the
6 peripheral device.

1 26. [Original] The computer instruction signal of claim 21, wherein the
2 peripheral device is chosen from a group consisting of: facsimile machines,
3 photocopiers and printers.

1 27. [Original] The computer instruction signal of claim 21, wherein the
2 computer instruction signal embodied in the carrier wave carrying instructions
3 that cause the processor to determine comprises a computer instruction signal
4 carrying instructions that when executed cause the processor to determine that
5 a usage threshold indicative of need for preventive maintenance has been met.

1 28. [Previously Presented] The method of claim 1, wherein the
2 combining comprises combining using the peripheral device.

1 29. [Previously Presented] The method of claim 1, wherein the
2 transmitting comprises transmitting using the peripheral device.

1 30. [Previously Presented] The method of claim 29, wherein the
2 transmitting comprises transmitting the electronic message comprising an order
3 with respect to a consumable of the peripheral device.

1 31. [Previously Presented] The method of claim 29, wherein the
2 transmitting comprises transmitting the electronic message comprising an order
3 with respect to maintenance of the peripheral device.

1 32. [Previously Presented] The method of claim 1, wherein the
2 combining and the transmitting comprise combining and transmitting using the
3 peripheral device.

1 33. [Previously Presented] The method of claim 1, wherein the
2 transmitting comprises transmitting responsive to the determining.

1 34. [Previously Presented] The method of claim 1, wherein the
2 transmitting comprises transmitting using the peripheral device and in the
3 absence of communications received by the peripheral device from a device
4 external of the peripheral device.

1 35. [Previously Presented] The article of manufacture of claim 8,
2 wherein the computer usable medium is in communication with the processor
3 comprising a processor of the peripheral device.

1 36. [Previously Presented] The computer implemented control system
2 of claim 15, wherein the processing circuitry comprises processing circuitry of
3 the hard copy output engine.

1 37. [Previously Presented] The computer implemented control system
2 of claim 15, wherein the memory and the processing circuitry comprise memory
3 and processing circuitry of the hard copy output engine.

1 38. [Previously Presented] The computer instruction signal of claim
2 21, wherein the processor comprises a processor of the peripheral device.

1 39. [Previously Presented] The method of claim 1, wherein the unique
2 device identifier uniquely identifies the peripheral device.

1 40. [Previously Presented] The method of claim 28, wherein the
2 peripheral device comprises a hard copy output engine.

1 41. [Previously Presented] The method of claim 29, wherein the
2 peripheral device comprises a hard copy output engine.

1 42. [Previously Presented] The computer implemented control system
2 of claim 15, wherein the unique device identifier uniquely identifies the hard
3 copy output engine.

IX. APPENDIX B – EVIDENCE APPENDIX

Appellants submit no evidence with this appellate brief.

X. RELATED PROCEEDINGS APPENDIX

Appellants are not aware of any related proceedings.